

- 4 surface and a cornered outer surface parallel to said cornered inner surface, said
5 single support member having first and second support flanges extending outwardly
6 from the first and second portions of the single support member respectively, said
7 first and second flanges extending continuously along the entire length of the first
8 and second portions.

Please cancel claims 6-12.

REMARKS

Upon entry of this Amendment, claims 1-5 are amended. Claim 1 has an additional change from the Amendment of August 3, 2000. Claims 6-12 are cancelled to reduce the issues. Claim 5 has an additional change from the Amendment of August 3, 2000. Claims 1-5 are pending. The Amendment to claims 1-5 are requested to more clearly define the invention and place them in condition for allowance or in better form for Appeal.

The Reissue Oath/Declaration originally filed with application was considered defective. The Examiner enumerated the deficiencies in the Reissue Oath/Declaration, as required by 37 C.F.R. 1.63. A new and Supplemental Reissue Declaration will be submitted at a later date as permitted by the Examiner in a telephone interview.

Claims 5-8 were rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the Examiner indicates that there was an inadequate written description of "at least two single members" and the relationship. Claims 6-8 have been cancelled. Claim 5 has been amended to delete the phrase "at least two single members." Other changes to claim 5 will be discussed hereinafter.

Claims 1, 2, 4-6, 8-10, and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,091,316 to Hauck. The Examiner alleges that Hauck provides in Figure 2, a member 6 having first and second longitudinally

extending portions defining a cornered inner surface each having a radially outwardly extending flange 5.

The rejection to claim 1 under 35 U.S.C. § 102(a) with regard to Hauck is traversed. Hauck does not show or disclose a first support flange lying in the first plane and extending outwardly from the first portion. Further, Hauck does not show or disclose a second support member flange lying in the second plane and extending outwardly from the second portion. The Examiner refers to Figure 2 in Hauck and indicates that item 6 is the member and that item 5 is the radially outwardly extending flange. But flange 5 does not extend outwardly from either a first or second portion of member 6. Although flange 5 does extend beyond portions of member 6, flange 5 does not extend from portions of member 6. Portions of item 5 are positioned adjacent to member 6 and therefore the flange portion of item 5 extends from the portions of item 5 that are adjacent to member 6 and NOT from member 6 itself. Further, item 5 and item 6 in Hauck are two different materials as defined in column 2, lines 4-6 and lines 11-13 in Hauck and cannot be a single member as required by claim 1. Since the items 5 and 6 in Hauck are different materials this makes it inherently difficult (if not impossible) for the metal flange 5 to extend from the wood member 6.

In addition, claim 1 has also now been amended to require that the support member flange lies in the first plane and extends outwardly from the first portion a predetermined distance and extend continuously along the entire length of the first portion and from the cornered inner surface radially outwardly. Further, claim 1 has been amended to require that the second support member flange lies in the second plane and extends outwardly from the second portion a predetermined distance and extends continuously along the entire length of the second portion and from the cornered inner surface radially outwardly. (The term "cornered" for the inner surface is added in this Amendment in lines 16 and 21 of claim 1. It is supported by Figures 1 and 3.) The Examiner states that Hauck provides a member 6 and radially outwardly extending flanges 5. Since the item 5 is a distinct and separate piece from member 6, the flanges formed from 5 do not extend from the cornered inner surface of member 6 radially outwardly. Items 5 and 6 in Hauck do not share the same cornered inner surface. The flanges 5 in Hauck extend adjacent to the

cornered inner surface of member 6 but the flanges 5 do not extend from the cornered inner surface as required in amended claim 1. Therefore, claim 1 is believed to be allowable over the prior art. Claims 2-4 as previously amended are dependent upon allowable claim 1 and are therefore believed to be allowable also.

Claim 5 has been rewritten to require an insulating support comprising: a single support member having first and second portions angularly disposed from each other. The first and second portions defining a cornered inner surface and a cornered outer surface parallel to the cornered inner surface. The single support member has first and second support flanges extending outwardly from the first and second portions of the single support member respectively. The first and second flanges extend continuously along the entire length of the first and second portions. (This Amendment to claim 5 is supported by Figures 1 and 3.)

Claim 5 is distinguished from Hauck in that the insulating support comprises a single support member having first and second portions and first and second support flanges. Hauck does not show or disclose an insulating support made from a single support member. Hauck requires two distinct members made from two separate materials abutted to each other to provide the corner finishing element. Further, the flanges in Hauck do not extend from the first and second portions of the single support member. Therefore, claim 5 is believed to be allowable over the prior art.

Claims 6-12 have been cancelled and therefore the rejection to those claims are not being addressed.

Claims 1-12 were rejected under the judicially created doctrine of double patenting over claim 1 of U.S. Patent No. 5,542,222. Once the claims are deemed to be allowable, a timely filed Terminal Disclaimer will be submitted.

Claims 1-12 were rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. The Examiner states that a broadening aspect is present in the reissue which was not present in the application for patents. The Examiner alleges that the record of the application for the patent shows that the broadening aspect (in the reissue) relates to the subject matter that Applicants previously surrendered during the prosecution of the

application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. § 251 and that the broader scope surrendered in the application for the patent and cannot be recaptured by the filing of the present reissue application. The Examiner further states that the limitations "single member" and/or "wherein said first and second longitudinally extending portions have lengths corresponding to the length of the corner of the building" have been omitted from the claims. The Examiner states that these limitations were present in Amendments in Application Serial No. 08/639,698 filed on 4/29/96 and 12/06/96. The Examiner states that the Applicants' remarks in these Amendments contains arguments that these limitations make the claims allowable over the prior art of record and thus the omitted limitations to relate to subject matter previously surrendered in Application Serial No. 08/639,698.

The rejection of claims 1-5 under 35 U.S.C. § 251 is traversed. Amended claims 1-4 are, in fact, narrower than the original claims respectively and therefore the recapture rule does not apply to those claims. In the case *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), cited by the Examiner, the court ruled that the recapture rule bars a reissue claim that is broader than cancelled or amended claim in some aspects but narrower in others, if the reissue claim is as broad or broader in aspects germane to prior art rejection, but narrower in another aspect completely unrelated to the rejection. In new claim 5, the Applicants are only claiming what the Examiner considered germane to any prior art rejections. The Examiner states in the Notice of Allowance of Serial No. 08/639,698, now U.S. Patent No. 5,664,376, Part 3 (Examiner's Amendment, page 2, paragraph 3) that "the following is an Examiner's Statement for Reasons for Allowance: no prior art of record, alone or in combination, teaches or fairly suggests a support member having first and second support member flanges extending outwardly from first and second portions of a single member, respectively, the first and second flanges extending continuously along the entire length of the first and second portions." The aforementioned quotation indicates what the Examiner considered germane regarding prior art rejections. The Applicants are not claiming anything broader than what the Examiner stated was his reasons for allowance. The Applicants are now claiming in a new claim (claim 5) what the Examiner indicated was allowable; ergo what is

germane to any prior art rejection. In fact, claim 5 is almost verbatim to what the Examiner of Application Serial No. 08/639,698 states as allowable. Additional restrictions have been added to claim 5 to overcome the recently cited prior art of Hauck and Naka. Therefore, in light of the Examiner's Reasons for Allowance in the Application Serial No. 08/639,698 the limitation of "wherein the first and second longitudinally extending portions have lengths corresponding to the lengths of the corner of the building" are not germane to prior art rejections. The Court in *In re Clement* further stated that if the reissue claim is narrower in aspect germane to prior art rejection and broader in aspects unrelated to the rejection, than the recapture rule does not bar the claim, but other rejections are possible. Therefore the elimination of the phrase "wherein the first and second longitudinally extending portions have lengths corresponding to the lengths of the corner of the building broadens the claims in aspects unrelated to the rejection and therefore the recapture rule does not bar claim 5.

This Amendment should place this case in condition for passing to issue. Such action is requested.

The original patent or affidavit or declaration as to loss or inaccessibility of the original patent will be mailed to the Examiner shortly.

Respectfully submitted,

YOUNG & BASILE, P.C.



Darlene P. Condra
Attorney for Applicant(s)
Registration No. 37113
(248) 649-3333

3001 West Big Beaver Rd., Ste. 624
Troy, Michigan 48084-3107
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DPC/slc